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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,431	05/22/2001	Shalaby Wahba Shalaby	00537-183002	4602

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MILFORD, MA 01757

EXAMINER

MITCHELL, GREGORY W

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/762,431	<b>Applicant(s)</b> SHALABY ET AL.	
	<b>Examiner</b> Gregory W Mitchell	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to the remarks filed August 23, 2004. Claims 1-10 and 13-28 have been cancelled. Claims 11 and 12 are pending and are examined herein.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2004 has been entered.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 11, 12 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment to claim 11 is sufficient to overcome the 35 U.S.C. 112(2) rejection recited in the Office Action dated August 22, 2003. The 35 U.S.C. 112(2) rejections of claims 11 and 12 are hereby withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winner et al. (USPN 4487860) in view of Tess et al. (USPN 2729609).

Winner et al. teaches a composition for coating surfaces comprising an aqueous polyelectrolyte polymer intermixed with a phosphated polyester, in general (Abstract; col. 1, lines 9-17). Specific phosphated polyesters are taught to comprise dicarboxylic acids (e.g. phthalic acid, succinic acid, etc.), which are esterified with an excess of simple glycols (e.g. ethylene glycol, etc.). The terminal alcohols are then reacted with phosphoric acid to prepare a monophosphate resin. Winner et al. also teaches that small amounts of monocarboxylic acids can be used. See col. 5, line 66-col. 8, line 56.

Winner et al. does not specifically teach a phosphated polyester comprising one of the specific monomers recited in claim 11 of the instant Application.

Tess et al. teaches a surface coating composition comprising a polymer comprising a polybasic acid (e.g. phthalic acid, succinic acid, etc.), a polyhydric alcohol (i.e. a polyol or a glycol), a monocarboxylic acid, and an additional modifying agent (e.g. lactic acid) for non-drying alkyds (col. 1, line 15-col. 3, line 59).

It would have been obvious to one of ordinary skill in the art to modify the phosphated polyester of Winner et al. by adding lactic acid as a monomer component therein because (1) Winner et al. teaches phosphated polyesters, in general; (2) Winner et al. and Tess et al. are both drawn to compositions for coating surfaces; (3) Winner et al. and Tess et al. comprise similar components (i.e. dicarboxylic acids, polyols, and

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monocarboxylic acids); and (4) Tess et al. teaches that lactic acid is useful in such surface coating polymer compositions. One would have been motivated to utilize the lactic acid as a monomer in the compositions of Winner et al. because, as taught by Tess et al., such modifying agents are useful in preparing non-drying alkyds.

It is Examiner's position that Applicant's recitations of the "absorbable" nature of the polyester claimed in the instant Application does not render the claims patentable because the "absorbable" nature of the polyester is a property of said polyester. Accordingly, because Winner et al. in view of Tess et al. teaches the same polyester, it is Examiner's position that the particles rendered obvious by Winner et al. and Tess et al. will possess the properties claimed in claim 11. If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* of obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winner et al. and Tess et al. as applied to claim 11 above, and further in view of Kakizawa (USPN 5686540).

Winner et al. and Tess et al. apply as disclosed above. Winner et al. further teaches that small amounts of triethylene glycol can be used as the polyol for preparing the phosphated polyester taught therein (col. 8, lines 32-56). Neither Winner et al. nor

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Tess et al. specifically teaches a polyethylene glycol as a component of the polyesters taught therein. It is noted, however, that triethylene glycol is, at a minimum, an oligoethylene glycol segment and could, itself, be considered a polyethylene glycol segment.

Kakizawa teaches a lactic acid based polyester comprising a dicarboxylic acid component (e.g. phthalic anhydride, succinic acid, etc.) and a diol component (col. 4, lines 57-62). The diol component is taught to be either a small glycol, such as ethylene glycol, or a polyoxyalkylene, such as polyethylene glycol (col. 6, lines 36-53). Polyoxyalkylenes are taught to provide excellent flexibility (col. 6, lines 47-53).

It would have been obvious to one of ordinary skill in the art to substitute the simple glycol of the phosphate polyester rendered obvious by Winner et al. and Tess et al. with a polyethylene glycol because (1) Winner et al. teaches that triethylene glycols may be used in the invention taught therein; (2) Kakizawa is an analogous art to both Winner et al. and Tess et al. (each invention is drawn to a polyester comprising a dicarboxylic acid component and a diol component); and (3) Kakizawa teaches that polyoxyalkylenes, generally, and polyethylene glycols, specifically, are useful in polyesters comprising a dicarboxylic acid component and a diol component. One would have been motivated to modify the polyester rendered obvious by Winner et al. and Tess et al. in the manner described above because, as taught by Kakizawa, such a modification would provide excellent flexibility.

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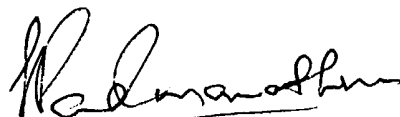
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER